

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HANS DILLER

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Appeal No. 98-0981  
Application No. 08/263,852<sup>1</sup>

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ON BRIEF

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Before MEISTER, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellant's request for rehearing<sup>2,3</sup> of our decision mailed November 20, 1998, wherein we

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<sup>1</sup> Application for patent filed June 22, 1994.

<sup>2</sup> Filed January 15, 1999.

<sup>3</sup> Effective Dec. 1, 1997, 37 CFR § 1.197(b) was amended to change the term "reconsideration" to "rehearing." See the final rule notice published at 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)).

reversed the examiner's rejection of claims 5 through 7 and 27 through 32 under 35 U.S.C. § 103 and added a new rejection of claims 5 through 7 and 27 through 32 under 35 U.S.C. § 112, second paragraph, pursuant to provisions of 37 CFR § 1.196(b).

On pages 7-8 of our decision we stated

Claims 5 through 7 and 27 through 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims drafted in means-plus-function format are subject to the definiteness requirement<sup>4</sup> of 35 U.S.C. § 112, second paragraph:

[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

In re Donaldson, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc); see also In re Dossel, 115

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<sup>4</sup> Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

F.3d 942, 946-47, 42 USPQ2d 1881, 1884-85 (Fed. Cir. 1997).

After review of the appellant's disclosure, it is our opinion that such disclosure fails to adequately disclose what structure corresponds to the claimed "pivotal means disposed between said car body and said second carriage permitting free pivotal movement of said car body about a generally horizontal axis relative to said second carriage as said pin means sliding in said groove causes said car body to pivot about said generally horizontal axis relative to said first carriage." The second paragraph of page 4 of the specification provides written description support for the claimed "pivotal means." However, that description does not specifically disclose the structure that corresponds to the claimed "pivotal means." Thus independent claim 27 and its dependent claims fail to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The sole argument (pp. 2-3) raised by the appellant is that the appellant's disclosure provides "full and complete support" for the structure of the "pivotal means" recited in independent claim 27. Specifically, the appellant directs our attention to Figures 12, 13 and 14 and the discussion of those figures found on pages 12 and 13 of the specification.

We have carefully considered the argument raised by the appellant in the request for rehearing, however, that argument

does not persuade us that our decision was in error in any respect. In that regard, the claimed "pivotal means" is recited as being **disposed between the car body and the second carriage** permitting free pivotal movement of the car body about a generally horizontal axis relative to the second carriage as said pin means sliding in the groove causes the car body to pivot about the generally horizontal axis relative to the first carriage. However, the coupling heads disclosed in Figures 12-14 are disposed between a first freight car and a coupled rear freight car so that the first freight car can be tilted independently of the rear freight car as is the case when the first freight car is traversing a curve, while the rear freight car is still on a straight track (specification, p. 12, lines 20-23). Thus, the disclosed coupling heads are to couple together two different freight cars. The claimed "pivotal means" is structure provided on a single car body<sup>5</sup> "disposed between said car body and said second carriage." Accordingly, the disclosed coupling heads are not structure that corresponds

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<sup>5</sup> Claim 27 recites "a first and second carriage underlying said car body."

to the claimed "pivotal means." Thus, it remains our view that independent claim 27 and its dependent claims fail to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

In light of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

No period for taking any subsequent action in connection  
with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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Application No. 08/006,717

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# ON REQUEST FOR REHEARING

APPEAL NO. 98-0981 - JUDGE NASE  
APPLICATION NO. 08/263,852

APJ NASE

APJ FRANKFORT

APJ MEISTER

DECISION: **DENIED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 10 Feb 99

**FINAL TYPED:**